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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/352,734	07/13/1999	JAMES OWEN	SLA0193	2607

7590 11/30/2004
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EXAMINER

DANG, DUY M

ART UNIT PAPER NUMBER

2621

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/352,734

Applicant(s)

OWEN ET AL.

Examiner

Duy M Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/28/04 has been entered.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al. (US Patent No. 5,659,164. Art of record IDS (paper #2) filed 10/18/1999).

Regarding claim 1, Schmid teaches a method for controlling scanning device using control sheets (i.e., the "MRI such as the bar-coded information" shown in figure 1 and mentioned in col. 4 lines 22-28 functions as the so called "controlling scanning device using control sheets"), comprising the steps of:

starting an imaging job having a multiple sheets (i.e., the "start scanner" shown at 14 of figure 3A; "place stack in feeder" shown in figure 2A; and "preparing a stack of successive sheets...digitizing scanner" mentioned in col. 3 lines 34-41. Also refer to "beginning of the document scanning" mentioned in col. 3 lines 42-43), wherein at least one sheet is a control sheet containing only a control image and there is only one control sheet containing operating instructions per image job (see "cover page 1" and "cover page 1¹" comprising MRI and HRI

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according to figure 1. Note that the MRI and HRI refer to the so called "control image". This interpretation is consistent with application's disclosed page 3 lines 9 and 11-12 that of "control image could be a text" and "control image could also be in machine-readable code". In addition, the two cover pages ("cover page 1" and "cover page 1¹") shown in figure 1 meet the so called "at least one sheet is a control sheet");

locating the control image on the control sheet within said imaging job (i.e., the "place documents with cover sheets on scanner feeder" shown at 6 of figure 3A and "recognizing...reading the machine-readable code markings of the cover sheet" mentioned in col. 3 lines 41-44 and the text portion mentioned in col. 4 lines 22-37),

processing (i.e., the "analyze, recognize" shown at 20 of figure 3B. Also refer to "computer (CP)" shown in figure 2A and mentioned at col. 4 lines 32-37) control instructions (i.e., the "machine code" shown at 20 of figure 3B) from said control image (i.e., the "machine code" shown at 20 of figure 3B and the "MRI" mentioned in col. 4 lines 22-28 correspond to the so called "control instructions"); and

creating output in accordance with said control instructions (i.e., the "recording cover sheet info routing ID, config. parameter, etc." shown at 24 of figure 3B, and the "digital format" mentioned in col. 4 line 40).

Schmid fails to expressly teaches wherein the control sheet could be located in a position other than at a first page of the imaging job. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to place the control sheet in a position other than at a first page of the imaging job. Applicant has not disclosed that placing the control sheet in a position other than at a first page of the imaging job provides an advantage. One of ordinary

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skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either location of the control sheet taught by Schmid or the claimed location of the control sheet because both locations perform the same function of imaging document.

Therefore, it would have been obvious to combine to one of ordinary skill in this art to modify Schmid's location of the control sheet to obtain the invention as specified in claim 1.

Regarding claim 8, Schmid teaches a method for controlling scanning device using control sheets [see figure 2A and the two cover pages (i.e., cover page 1 and cover page 1¹) shown in figure 1] comprising the step of:

starting an imaging job having multiple sheets (i.e., the "start scanner" shown at 14 of figure 3A; "place stack in feeder" shown in figure 2A; and "preparing a stack of successive sheets...digitizing scanner" mentioned in col. 3 lines 34-41. Also refer to "beginning of the document scanning" mentioned in col. 3 lines 42-43), wherein at least one sheet is a control sheet containing only control information and there is only one control sheet containing operation instructions for the imaging job (see "cover page 1" and "cover page 1¹" comprising MRI and HRI according to figure 1. Note that the MRI and HRI refer to the so called "control image". This interpretation is consistent with application's disclosed page 3 lines 9 and 11-12 that of "control image could be a text" and "control image could also be in machine-readable code". In addition, the two cover pages ("cover page 1" and "cover page 1¹") shown in figure 1 meet the so called "at least one sheet is a control sheet");

locating a control image on the control sheet within said imaging job (i.e., the "place documents with cover sheets on scanner feeder" shown at 6 of figure 3A and

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“recognizing...reading the machine-readable code markings of the cover sheet” mentioned in col. 3 lines 41-44 and the text portion mentioned in col. 4 lines 22-37);

creating output for said imaging job (i.e., the “recording cover sheet info routing ID, config. parameter, etc.” shown at 24 of figure 3B and the “digital format” mentioned in col. 4 line 40); and

processing (i.e., the “analyze, recognize” shown at 20 of figure 3B) control instructions (i.e., the “machine code” shown at 20 of figure 3B) from said control image and using said control instruction for managing said output (i.e., the “set scanner parameters command: resolution, dither, mode, etc.” shown at 23 of figure 3B).

Schmid fails to expressly teaches wherein the control sheet could be located in a position other than at a first page of the imaging job. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to place the control sheet in a position other than at a first page of the imaging job. Applicant has not disclosed that placing the control sheet in a position other than at a first page of the imaging job provides an advantage. One of ordinary skill in the art, furthermore, would have expected Applicant’s invention to perform equally well with either location of the control sheet taught by Schmid or the claimed location of the control sheet because both locations perform the same function of imaging document.

Therefore, it would have been obvious to combine to one of ordinary skill in this art to modify Schmid’s location of the control sheet to obtain the invention as specified in claim 8.

Regarding claims 2, and 9, Schmid further teaches an image acquisition task (i.e., the “scanner” shown in figure 2C and mentioned in col. 3 lines 39-41 functions as the so called “an image acquisition task”).

Regarding claims 3, and 11, Schmid further an image production task (i.e., the scanning document and storing document as a digitized document mentioned in col. 5 lines 35-38 functions as the so called “an image production task”).

Regarding claims 4, and 12, Schmid further teaches a machine-readable format (i.e., the stack of pages shown in figure 1 contained printed information according to col. 2 lines 23-27 satisfies the so called “a machine-readable format”).

Regarding claims 5, and 13, Schmid further teaches wherein said control image is text (i.e., the “human readable information (HRI)” shown in figure 1, and “printed information” (i.e., handwritten) mentioned in col. 2 lines 23-28).

Regarding claims 6, and 14, Schmid further teaches wherein said control image is numbers (i.e., the “human readable information (HRI)” shown in figure 1, “MRI” shown in figure 4 (note the numbers printed below barcode), and “printed information” (i.e., handwritten) mentioned in col. 2 lines 23-28 satisfy the so called “numbers”).

Regarding claims 7, and 15, Schmid further teaches wherein said method includes the steps of locating a second control image on the second control sheet containing information other than operating instructions for the same image job (i.e., the cover page 1 shown in figure 1 corresponds to the so called second control sheet) and processing the second control image (refer to the “analyze, recognize machine code” shown at 20 of figure 3B and col. 4 lines 22-37).

4. Applicant's arguments filed 10/28/04 have been fully considered and hey are persuasive.
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M Dang whose telephone number is 703-305-1464. The examiner can normally be reached on Monday to Friday from 5:30AM to 2:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H Boudreau can be reached on 703-305-4706. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

dmd
11/23/04

A handwritten signature in black ink, appearing to read 'Duy M. Dang', with a long horizontal flourish extending to the right.

Duy M. Dang
Patent Examiner